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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,121	01/16/2001	Robyn R. Levine	END920000173US1	2906

7590 12/09/2008

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ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
12/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/761,121
Filing Date: January 16, 2001
Appellant(s): LEVINE, ROBYN R.

John R. Pivnichny
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 10, 2006 appealing from the Office action mailed November 16, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. Appellant states that the amendment filed after the Final Action of 11/16/05 was filed 01/16/06 and the Examiner did not indicate whether the amendment will or will not be entered for purpose of appeal. Appellant only presented argument, no amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claims 1-9, 12-18 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,101,486	ROBERTS et al.	8-2000
6,829,475	LEE et al.	12-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 6, 9, 12-16, 18 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al. U.S. Patent No. 6,101,486.

Regarding claims 1-3, Roberts teaches determining point of contact constraints of user (see col. 5 lines 25-40); retrieving a profile and current action of user, which is grouped to presenting a lifestyle or lifestage view of user (see col. 6 line 60 to col. 7 line 16) and delivering content (opportunity) to user, delivered to the user based on the point of contact, profiled past and current action; wherein the point of contact comprises of computer, set top or television with Internet access; (see fig. 3&4, col. 4 lines 24 to col. 5 lines 40, col. 6 lines 12 to col. 7 line 46). Robert teaches delivering an opportunity to user *by creating a vision of a supplier's core competencies based on* constraints of said point of contact and profiled past and current action (personalized or customized information message) (see col. 6 line to col. 7 lines 10), *consistent with the vision by merging together and optimizing said vision with the suppliers channel awareness* (providing voice communication with the customer (see col. 5 line 25 to col. 6 line 11).

Regarding claims 6, 9 and 12-16, Roberts teaches profile including demographic data; layered demographic profile; block or group (see col. 4 lines 33-67); wherein the profiled past includes data generated by data-mining of navigational and transaction information or user submitted data or purchased data or combination thereof (see col. 5 line 65 to col. 6 line 13); current action including transaction including of listings of purchases or payment; current action including click-stream data such as page hits, sequence of hits, duration etc., (see col. 4 lines 33-44, col. 5 lines 1-24 and col. 6 line 36 to col. 7 line 9).

Regarding claim 18, Roberts teaches sending a personalized web page to user (see col. 2 line 60 to col. 3 line 10, col. 6 lines 12-35, col. 7 lines 10-17).

Regarding claim 20, Roberts teaches delivering a take action opportunity (see 4 lines 44-67, col. 5 lines 55 to col. 6 line 11).

Claims 21-23 are rejected as stated above in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5, 7, 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. U.S. Patent No. 6,101,486 further in view of Lee et al. U.S. Patent No. 6,829,475.

Regarding claims 4 and 5, Robert does not teach point of contact constraints includes a location indication including GPS system coordinates. Lee teaches GPS receiver 110 that continuously reports the vehicle's longitude, latitude and altitude, location indication and providing advertisements (col. 11 line 60 to col. 12 line 3). Lee teaches providing mapping services to the vehicle showing travel routes or locations of interest and coupled with the advertising database drivers can see map locations related to recent advertisements and get navigation guidance to these locations. For example, the driver could get directions to the nearest chain restaurant whose commercial just played offering a lunch special. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a location enhanced advertisement or opportunity, as in Lee, in Robert's customized marketing message in order to provide the advantage taught by Lee.

Regarding claims 7 and 8, Roberts does not explicitly teach anonymous demographic data supplied by third party. Official notice is taken that is old and well known to acquire user's anonymous demographic profile from a third party, such as ISP. It is well known for third party to provide information without compromising the privacy of users. Therefore, it would have been obvious to one ordinary skill in the art to supply anonymous data, since users are hesitant to provide their information to third parties for privacy reasons.

Regarding claim 17, Roberts teaches the click-stream including data such as page hits, sequence of hits, duration of page views, response to advertisement, transaction, (see col. 4 lines 33-44, col. 5 lines 1-24 and col. 6 line 36 to col. 7 line 9), however Roberts does not explicitly teach conversion rate of the opportunity. Official Notice is taken that is old and well know to calculate the rate of ads displayed and ads viewed in art of marketing. It would have been obvious to one of ordinary skill in the art at the time of the invention to divide the number of hits by the number of displayed advertisement to calculate the ratio since the ratio would indicate the number of times the ad need to be displayed to achieve what the advertiser considers to be acceptable hits.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9, 12-18 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v.* Diehr, 450 U.S. 175, 184 (1981); *Parker v.* Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.* Benson, 409 U.S. 63, 70 (1972); *Cochrane v.* Deener, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance

with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-9, 12-18 and 20 fail to meet the above requirements.

(10) Response to Argument

Appellant argues that Roberts does not teach the second step of the claimed invention, i.e., *retrieving a profile past of the user,* including purchase data which is grouped or keyed to presenting a lifestyle or lifestage view of the user. Appellant asserts that the Examiner's cited sections col. 5 lines 4-25 and col. 6 line 60 to col. 7 line 16, as teaching the second and third step does not describe or suggest the second step of appellant's claim. Appellant argues that col. 5 lines 4-25 describe collecting keyboard entries, mouse clicks and voice commands to a microphone, such collection may correspond to Appellant's first step and third step. Appellant argues that there is no purchase data of the any type described or suggested in the cited parts of Roberts.

Examiner would like to point out, the cited section includes fig. 3&4, col. 4 lines 24 to col. 5 lines 40, col. 6 lines 12 to col. 7 line 46, which discloses the database storing customer profile information. Roberts teaches the profile includes any user identification, other useful data such as *previous purchases and a listing of products and services currently owned, and the products owned are directly entered into the profile*. Robert further teaches the *profile information includes any product selections the customer makes while visiting the website* and any specialized or customized features desired by the customer are also included in the profile information (see col. 4 lines 24-67). Roberts also teaches a questionnaire or survey would allow the CSR to gain insight into a customer's personal interest or attribute characteristics, and the

information obtained could include the customer's personal interest such as desired vacation destinations, frequency of business travel, the consumer demeanor, desired product and service; the additional information is added to the profile and used to better service the consumer in the future. Roberts discloses that comparison between the customer profile and company database is performed to create listing of products not currently owned or used by the consumer and of potential interest to the user (see col. 6 lines 2-67). Roberts further discloses that the *customer profile includes listing of services and products currently possessed by the customer (col. 6 lines 44-67).* Robert also teaches the information (purchased data) keyed or grouped to presenting lifestyle or lifestage view of the user (gather information about the consumer' interest) see col. 5 lines 20-24. Roberts also teaches the *profile information would keep track of certain attitudes, interests or preference attributes, for instant customer that eager to try new products and services may be distinguished from those that are more conservative in their willingness to experiment,* same as appellant's invention (see col. 6 line 65 to col. 7 line 9).

Appellant also argues that the claim requires in the fourth step a vision of a supplier' core competencies be created based on the constraints, profile past, and current actions recited in the first three steps. Appellant asserts that Roberts is incapable of creating such vision because as stated above, Roberts does not describe all the requirements of the second step on which the vision must be based. Since it is indicated above that Roberts discloses all the requirements of the second step, Roberts is capable of delivering an opportunity to the user by creating a vision of a supplier core competences based on the three steps. Examiner's interpretation of the "delivering an opportunity by creating a vision of supplier's core competencies" is equivalent to delivering content or opportunity to effectively drive the user to reaction desired by the merchant

(supplier) as disclosed in appellant's specification (see page 14 par.1) which is performed by customizing or personalizing the content or opportunity. As indicated above Roberts teaches delivering an opportunity to user based on past profile including purchased data and point of contact constraints, and current action, same as applicant's disclosed invention.

According to Appellants disclosure the content (page 14) is delivered by creating a vision of the supplier's core competencies based on the user-centered perspective of point of contact 12 (device used by user) profile past and current actions 16. Further the specification teaches current promotional opportunities 32 are developed consistent with the vision *by merging together and optimizing this user centered perspectives with the supplier's channel awareness* whether voice-to-voice, V2V, or face-to-face, F2F or fingertip device. Roberts teaches providing voice communication with the customer (see col. 5 line 25 to col. 6 line 11) or displaying message, customizing the page (see col. 7 lines 10-17, see also abstract).

Regarding claim 13, Appellant argues that col. 5 line 65 to col. 6 line 13 merely describe a customer service representative (CRS), e.g., a person having a telephone interaction with the customer, using a questionnaire or survey to gather information. Appellant asserts that there is no description or datamining as this term is used in the art, anywhere in the cited portion of Roberts.

Examiner would like to point out again the cited section includes col. 4 lines 33-44, col. 5 lines 1-24 and col. 6 line 36 to col. 7 line 9 which discloses in addition to active input operations the cookie logging the customer's passive activity including click-stream data such as page hits, sequence of hits, duration etc., (see col. 5 lines 2-24). Claim 13 however recites that said profiled past **includes** data generated by datamining of navigational and transactional information, **or** user submitted data (Roberts questionnaire or survey) **or** purchased data **or** combinations

thereof. The prior art reference needs to show only one feature. However in this case Roberts teaches not only data generated by datamining of navigational and transaction information (logging customer's input operations using "cookie") but every limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any

amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Yehdega Retta /Yehdega Retta/
Primary Examiner, Art Unit 3622

Conferees:

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622

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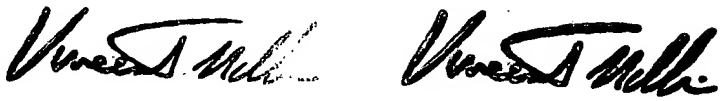

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below: